

REMARKS

The above-reference application has been reviewed in light of the Office Action mailed January 9, 2006. It is respectfully submitted that the claims presently pending in the application, namely 1, 2, and 4-15 are fully supported by the application and are patentable over the prior art. Prompt and favorable consideration of these claims is earnestly sought.

Claims 1-2, 4-5 and 13-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,096,037 to Mulier et al. (hereinafter "Mulier") in view of U.S. Statutory Invention Registration No. H2037 H to Yates et al. (hereinafter "Yates"). In the Office Action, the Examiner states that Mulier discloses a bipolar electrosurgical instrument essentially as claimed except for a stop for maintaining a separation distance between the opposable seal surfaces and the specific range of closure pressure of about 7-13 kg/cm². The Examiner also maintains that a stop between the opposable seal surfaces would have been obvious to a skillful artisan. The Examiner further contends that Yates discloses an electrosurgical hemostatic device wherein the range of closure pressure for forming a required tissue seal is 30-250psi, and therefore, overlaps the claimed range.

Mulier discloses a bipolar electrosurgical instrument for sealing tissue having jaw members configured to infuse fluid into tissue positioned between the members. As described in the specification, "[i]nfusion of fluid through the jaws is to be maintained in a continuous flow during and throughout the application of RF energy in order for the desired tissue effect to be achieved." (Column 5, lines 46-49). The specification continues, "[t]he conductive solution infused onto and into the tissues maintains relatively consistent maximal electrical contact areas, substantially preventing hot spots and allowing higher power than soft coagulation." (Column 5, lines 53-56). Mulier teaches an instrument that uses a continuous flow of fluid infused through

the jaw members to prevent desiccation of the tissue. In turn, the tissue prevents the jaw members from contacting one another. Thus, tissue must be positioned between the contacting surfaces of the jaw members while receiving the continuous fluid flow infusing the tissue in order for the instrument to function as a sealing device in accordance with the disclosure. Inclusion of a stop would be redundant and would only interfere with the operation of the jaw members of the instrument as taught by Mulier. Therefore, there would be no suggestion to include a stop between the jaw members of the instrument taught by Mulier.

In further evidence that the use of stop for maintaining a separation distance between the opposable seal surfaces is not obvious, Mulier teaches away from such an application. The specification reads, “if the invented device is incorporated in forceps,...the jaw may close into full and tight contact with each other...” (column 8, lines 23-38). Thus the jaw members of the instrument taught by Mulier were not intended to be separated by anything more than the fluid infused tissue positioned between the jaw members. Applicants respectfully submit that the addition of a stop to the instrument taught by Mulier would not have been obvious, and respectfully request the rejection of claims 1 and 13, as obvious, be withdrawn. Since claims 2 and 4-5 depend from claim 1, and claim 14 depends from claim 13, for the reasons noted above, Applicant respectfully submits claims 2, 4-5 and 14, are also in condition for allowance.

Additionally, Mulier teaches an instrument that requires electricity and a continuous flow of fluid infused into the tissue in order to create a tissue seal. A specific closure pressure is not required for the instrument taught by Mulier to operate when tissue is being sealed. Therefore, there would be no suggestion to regulate the amount of closure pressure applied to the jaw members. Further, Yates teaches:

“with sufficient pressure applied, fluid, including blood, is forced out of the tissue in the compression zone, facilitating coagulation. In addition, pressure

applied to tissue within the compression zone facilitates coupling of electrosurgical energy to the tissue by forcing the tissue against the electrode.” (Column 8, lines 56-61).

As described above, the instrument disclosed by Mulier necessitates a fluid infused tissue to effectuate proper sealing. The combination of the instrument disclosed in Mulier with the pressure range described in Yates would render the Mulier instrument inoperable. Applying the closure pressure taught by Yates with the instrument disclosed by Mulier would force all of the fluid from the tissue and prevent any further fluid from infusing into the tissue. Without a continuous flow of fluid infused into the tissue while energy is being applied to the jaw members, the instrument disclosed by Mulier would not operate as disclosed.

Claims 6-12 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mulier and Yates as applied to claim 6 above and further in view of U.S. Patent no 6,860,880 to Treat et al. (hereinafter “Treat”). The Examiner relies on the combination of Mulier and Yates, as described above, and further states that Treat discloses an instrument for sealing tissue wherein the opposable seal surfaces include a non-stick material such as nichrome or an alloy thereof for such a purpose. As reasoned above, it would not have been obvious to include a stop for maintaining a separation distance between the opposable seal surfaces of the instrument disclosed by Mulier. Further, there is a teaching away for utilizing the closure pressure range disclosed in Yates with the instrument taught by Mulier. Treat does not provide any further teaching or suggestion that, in combination with Mulier or Yates, would suggest the bipolar surgical instrument as recited in claims 6 and 12. For the reasons presented above, it is respectfully submitted that the rejection of claims 6 and 12 should be withdrawn. Since claims 7-11 and 15 depend from claim 6, and claims 7-11 and 15 contain all of the elements of claim 6,

for the reason presented above, claims 7-11 and 15 are also believed to be in condition for allowance.

In light of these amendments and remarks, favorable consideration and allowance of all outstanding claims are earnestly solicited. Should there be any questions after the Examiner's review of this paper; the Examiner is invited to contact the undersigned at (631) 501-5708.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Raymond E. Farrell', is written over a horizontal line.

Raymond E. Farrell
Attorney for Applicants
Reg. No. 34,816

CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road - Suite 225
Melville, New York 11747
631-501-5702 (T)
631-501-3526 (F)